

The opinion in support of the decision being entered
today was not written for publication and
is not binding precedent of the Board

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIETER MULLER

Appeal No. 2003-0826
Application No. 09/214,047

ON BRIEF

Before SCHEINER, MILLS, and PAWLIKOWSKI, Administrative Patent
Judges.

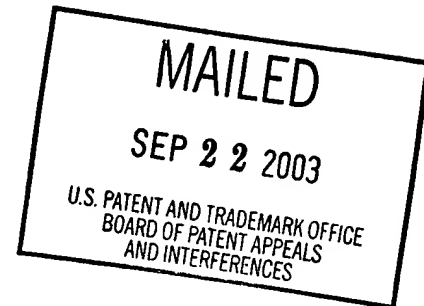
PAWLIKOWSKI, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the examiner's refusal to allow
claims 1, 3, 4, and 5.

One of the rejections of record is a rejection of claim 1
under 35 U.S.C. § 102(b) over a German foreign reference
(Brenner). This reference was made of record in an IDS submitted
by appellant on July 19, 2000. The IDS indicates that no English
translation was provided.

Throughout prosecution of this case, the examiner refers to
only the Abstract of Brenner.



Appellant's Appeal Brief was filed on July 2, 2002. The Answer was filed on September 24, 2002. An English translation of Brenner was found in the file and indicates that the translation was made by the U.S. Patent and Trademark Office on September 23, 2002, one day before the Answer was mailed. In the Answer, the examiner again refers only to the Abstract of Brenner, and no PTO 1449 form is of record indicating that an English translation was mailed to appellants. Therefore, we request that the examiner provide a copy of the English translation of Brenner to appellants, and make such of record.

We further note that the record does not indicate 1) that the examiner reviewed the full translation and 2) that appellant was given an opportunity to respond to the contents of a full translation.

We note that abstracts, at best, are only short summaries of what is contained in the full document and their conciseness can distort what is taught in the full document. Here, we lack the views of the examiner and appellants, those most knowledgeable of the technology and prosecution, with regard to the critical evidence (full translation). Hence, we do not have a proper basis for our review at this point in time. See Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001).

We therefore remand this application to the examiner for consideration of the above-mentioned issues. If reliance upon the English translation in anyway constitutes a new ground of rejection, we authorize the examiner to reopen prosecution of the application. Otherwise, we authorize the examiner to file a Supplemental Examiner's Answer.

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This application, by virtue of its "special" status requires an immediate action, MPEP § 708.01(d) (8th Ed.) (Rev. 1, Feb. 2003).

It is important that the Board be promptly informed of any action (abandonment, reopening prosecution, etc.,) affecting the appeal in this application.

REMANDED

Toni R. Scheiner

Toni R. Scheiner)
Administrative Patent Judge)

Demetra J. Mills

Demetra J. Mills)
Administrative Patent Judge)

Beverly A. Pawlikowski

Beverly A. Pawlikowski)
Administrative Patent Judge)

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